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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/064, 765 04/23/98 OHNISHI

H 381TO/41092R

EXAMINER

PM51/1230  
EVENSON MCKEOWN EDWARDS & LENAHAN  
1200 G STREET NW  
SUITE 700  
WASHINGTON DC 20005

ZANELLI, M

ART UNIT	PAPER NUMBER
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3661

DATE MAILED:

12/30/98

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/064,765	Applicant(s) Ohnishi et al
Examiner M. Zmelli	Group Art Unit 3661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 4/23/98.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1 - 11 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) 1 - 7 is/are allowed.
- Claim(s) 8 - 11 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been  received.
- received in Application No. (Series Code/Serial Number) 07/985,199.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(e) \_\_\_\_\_  Interview Summary, PTO-413
- Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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**DETAILED ACTION**

1. This application is a Reissue of Patent No. 5,510,982, issued 4/23/96 and based on Application S.N. 07/985,199, filed 12/3/92. Patented claims 1-7 remain unchanged. Claims 8-11 have been newly added.
2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in the patent application file.
3. The drawings have been objected to by the draftsman as indicated on the enclosed form PTO-948. Applicant can request that the drawings from the patent file be transferred to the Reissue file. See MPEP § 1413.
4. The enclosed copies of forms PTO-1449 and PTO-892 list the references cited in the original patent application. No new references have been cited. See MPEP § 1455 ("References Cited and Printed").
5. This application is objected to under 37 CFR 3.73(b) as lacking evidence of the right of the assignee to take action. See MPEP § 324.

A proper assent of the assignee in compliance with 37 CFR 3.73(b) is required in reply to this Office action.
6. Claims 8-9 are rejected as being in violation of the recapture rule (see MPEP § 1412.02).

A. The patented claims are directed to an automatic transmission control which includes [means for] estimating the weight of a vehicle and a running load of a vehicle.

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In response to the examiner's rejection in view of the prior art, applicant argued that the claims recited "means for estimating a running load of the vehicle" and "means for estimating the weight of the automobile" and that such limitations are not found in the prior art. The applicant further stated that the advantage of including such means allowed the transmission to be adapted for differing operating circumstances (See amendment filed in patent application on 2/14/95, paper no. 16). Thus applicant relied on these limitations as distinguishing over the prior art and must be included in the Reissue claims. Such arguments in support of patentability over the prior art can trigger the recapture rule. See Hester Industries, Inc. v. Stein, Inc. (CAFC, May 7, 1998) (46 USPQ2d 1641).

7. Claims 8-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

A. Claim 8 recites a control system for an automatic transmission which controls the transmission based on a corrected estimated input torque. A correction torque is determined from the deviation of an input torque based on an engine torque characteristic and an input torque based on a torque-converter characteristic. The correction torque is used to correct the input torque estimated based on the engine torque characteristic and the result used to control the transmission.

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B. The patent specification describes embodiments in which the transmission is controlled using a shift schedule selected based on at least the running load and the estimated vehicle weight. Figures 1 and 10 illustrate systems which control the transmission in this manner. Further, cols. 1 and 2 of the patent disclose the problems with the prior art and the objectives of the invention to solve these problems; namely, adapting the control of the transmission based on changes in the running load and estimated weight.

C. The patent specification does not disclose or reasonably suggest an embodiment in which the estimated weight of the vehicle and running load are not considered. None of the disclosed embodiments suggest controlling the transmission based only on the deviation of input torques as claimed. The closest reference to the claimed subject matter is found in col. 8, lines 27-34 in which a difference (Terr) between the two input torques is calculated. However, this difference is used in evaluating an accessory torque (Tacc) and that value is subtracted from the engine torque (col. 8, lines 35-46). Even if one assumed the corrected torque was determined as claimed, the corrected torque is not used by itself to control the transmission, but in conjunction with estimated vehicle weight, running load, gear ratio, etc. (see Fig. 10). Thus, the invention as now claimed is not fully described in the original patent.

D. In addition, claims 8-11 also fail to recite subject matter essential to the invention as disclosed. See MPEP § 2172.01.

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8. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. As per claims 8-11 in general, the claims fail to set forth subject matter which applicant regards as the invention. As noted in cols. 1-2 of the patent application, applicant states that the invention adaptively controls the transmission based on changes in the vehicle's estimated weight and running load. However, the claims fail to recite these essential elements in the apparatus as claimed. Further, the scope of the invention as claimed is not commensurate in scope with the invention as originally disclosed. The claims read on those systems which do not include a weight estimating means and a running load estimating means.

B. As per claim 8, the claim is unclear as recited. At line 11 the "estimated" input torque is corrected, not an actual input torque. The examiner suggests inserting "estimated" after "first". Also the claim is confusing as recited at line 14 ("said correction first input torque").

C. As per claim 9, the claim is confusing as recited at lines 4-5 ("said correction first input torque").

D. All claims depending from a rejected base claim are also rejected as containing the same deficiencies.

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9. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121(b).

10. Note if applicant amends the claims in response to this communication, a new/supplemental oath or declaration complying with 37 C.F.R. § 1.175 will be required. This requirement can be held in abeyance; however, the new/supplemental oath or declaration **must be submitted before allowance.**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is **(703) 305-9756** (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1113**.

/mjz  
December 21, 1998



MICHAEL ZANELLI  
PRIMARY EXAMINER